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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
|--|-------------|----------------------|---------------------------------|-----------------------------|
| 10/810,512   | 03/26/2004  | James R. Tighe       | 062891.1231                     | 1184                        |
| 5073   | 7590        | 07/27/2007           |                                 |                             |
| BAKER BOTTS L.L.P.<br>2001 ROSS AVENUE<br>SUITE 600<br>DALLAS, TX 75201-2980 |             |                      | EXAMINER<br>MOUTAOUAKIL, MOUNIR |                             |
|  |             |                      | ART UNIT<br>2616                | PAPER NUMBER                |
|  |             |                      | NOTIFICATION DATE<br>07/27/2007 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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5

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|------------------------------|--------------------------------|------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/810,512  | Applicant(s)<br>TIGHE ET AL. |  |
|                              | Examiner<br>Mounir Moutaouakil | Art Unit<br>2616             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Drawings***

3. The drawings 3a, 3b, and 3c are objected to under 37 CFR 1.83(a). The drawings must be labeled descriptively with a legend. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 35-38 rejected under 35 U.S.C. 101 because they do not fall within one of the four categories of patentable subject matter of 35 U.S.C 101 (process, machine, manufacture, or composition of matter). The claim recites "logic for supporting communication", as best understood, logic is a program, and a program per se is not a patentable subject matter according to the interim guidelines.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8, 10-17, and 19-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Bales et al (US 5,574,724). Hereinafter referred to as Bales.

Regarding claims 1, 10, 35, and 39. Bales discloses a method for supporting communications. The method comprises establishing a packet-based audio communication link with a remote device (figure 1, 104 is interpreted as a remote

device, column 3, lines 5-31, the audio communication link is established with the remote device); informing a local computing device of the audio communication link (column 3, lines 5-35, 101 connects to the communication link); receiving a message from the local computing device (column 3, lines 32-60, a messages is transmitted and received), the message requesting identification of enhanced media capabilities associated with the remote device (104 receives a message regarding media capability associated with it); tunneling the message in the audio communication link to the remote device (column 3, lines 35-60. The message is transmitter while the call is already established. Therefore, the message request must be tunneled); receiving a tunneled response in the audio communication link from the remote device (column 3, lines 35-60. The system receives an acknowledgment regarding the transmitted request), the response identifying the enhanced media capabilities associated with the remote device (column 3, lines 35-60. An acknowledgment is received regarding the media capability of 103); and forwarding the response to the local computing device (101 receives an acknowledgment regarding the transmitted message).

Regarding claims 2, 11, 23 and 36. Bales discloses a communication method, which further comprises determining, at the local computing device, whether the enhanced media capabilities associated with the remote device include a particular enhanced media capability; and communicating enhanced media packets to the remote device in response to determining that the enhanced media capabilities associated with the remote device include the particular enhanced media capability (column 3, lines 35-60. Based on the acknowledgment received, the system determines if the system may

or may not support a video communication. If it may, the system initiates the video communication).

Regarding claims 3, 12, 24, 32 and 37. Bales discloses a communication method wherein the particular enhanced media capability is a video capability (column 3, lines 35-60. The media capability is a video capability), the enhanced media packets are video packets (figure 1 is a packet switching network), and communicating the enhanced media packets to the remote device comprises tunneling the video packets in the audio communication link to the remote device (column 3, lines 62-67. Audio and video packets are transmitted through the same channel).

Regarding claims 4, 13, 25 and 38. Bales discloses a communication method wherein the particular enhanced media capability is a video capability (column 3, lines 35-60. The media capability is a video capability), the enhanced media packets are video packets (figure 1 is a packet switching network), and communicating the enhanced media packets to the remote device comprises communicating the video packets in a second communication link to the remote device (column 3, lines 62-67. the audio channel and video channel are different channels).

Regarding claims 5, 14 and 26. Bales disclose a communication method that further comprises receiving enhanced media packets from the remote device and automatically displaying (figure 1. 101 is connected to a displaying device 106 to display incoming video from the 104), at the computing device, at least one enhanced media window in response to receiving the enhanced media packets from the remote device

(106 is interpreted as a displaying device. Inherently, Displaying a video will require the usage of a media window).

Regarding claims 6 and 15. Bales discloses a communication method wherein the particular enhanced media capability is an instant-messaging capability (column 3, lines 5-67. The media capability includes audio video capability. Audio video communication between at least two users is considered an instant messaging), the enhanced media packets are instant-messaging packets (fig.1. The system is packet based system), and communicating the enhanced media packets to the remote device comprises tunneling the instant-messaging packets in the audio communication link to the remote device (column 3, lines 62-67. The audio video packets may be transmitted over the same channel).

Regarding claims 7 and 16. Bales discloses a communication method wherein the audio communication link uses Real-time Transport Protocol (RTP) (it is inherent that the system uses a Real-time transport protocol).

Regarding claims 8 and 17. Bales discloses a communication method that further comprises halting communications on the audio communication link; and informing the local computing device of the halting of communications on of the audio communication link (column 3, lines 5-32. the user establishes the communication link through 101. it is inherent for the user to stop the link established through 101).

Regarding claims 19 and 22. Bales discloses a communication support apparatus. The apparatus comprises an interface operable to couple to a local computing device and a packet network (figure 1, 101 and 106); and a controller

coupled to the interface (102), the controller operable to establish a packet-based audio communication link with a remote device (104), to inform the local computing device of the audio communication link (column 3, lines 5-32), to receive a message from the local computing device (column 3, lines 32-60, a messages is transmitted and received), the message requesting identification of enhanced media capabilities associated with the remote device(104 receives a message regarding media capability associated with it), to tunnel the message in the audio communication link to the remote device (column 3, lines 35-60. the message is transmitter while the call is already established. Therefore, the message request must be tunneled), to receive a tunneled response in the audio communication link from the remote device column 3, lines 35-60. The system receives an acknowledgment regarding the transmitted request), the response identifying the enhanced media capabilities associated with the remote device (column 3, lines 35-60. An acknowledgment is received regarding the media capability of 103), and to forward the response to the local computing device (101 receives an acknowledgment regarding the transmitted message).

Regarding claim 20. Bales discloses an apparatus wherein the controller is further operable to tunnel enhanced media packets between the local computing device and the remote device in the audio communication link (column 3, lines 62-67 video packets are transmitted using a different channel or link).

Regarding claim 27. Bales discloses a method for supporting communications. The method comprises associating a packet-based telephony device (fig.1, 103) with a computing device (104); determining media capabilities associated with the packet-



based telephony device (column 3, lines 5-60); determining enhanced media capabilities associated with the computing device (fig.2); aggregating the media capabilities associated with the packet-based telephony device and the enhanced media capabilities associated with the computing device (fig.2); and registering the aggregating media capabilities with a call manager (101), the call manager operable to associate the aggregated media capabilities with the packet-based telephony device (fig.2).

Regarding claim 28. Bales discloses a method that further comprises establishing an audio communication link between the telephony device and a remote device using the call manager (the communication link is established through 101-107), the audio communication link supporting transmission of audio packets and embedded packets (column 3, lines 62-67. the audio link can embed video packets as well).

Regarding claim 29. Bales discloses a system for supporting communications. The system comprises a computing device operable to determine a first set of enhanced media capabilities associated with the computing device and to generate a message identifying the first set (fig 2. trans 201); a packet-based telephony device coupled to the computing device and operable to receive the message (fig.2, 102), to determine a second set of media capabilities associated with the telephony (device 204), to aggregate the first set and the second set into an aggregated set of media capabilities (202), and to communicate the aggregated set to a call manager (103, 202); and the call manager operable to associate the aggregated media capabilities with the packet-based telephony device (103 recognizes the media capabilities of 102).

Regarding claim 30. Bales discloses a system wherein the call manager is further operable to establish an audio communication link between the telephony device and a remote device (column 3, lines 5-32 an audio link is established), the audio communication link supporting transmission of audio packets and embedded packets (column 3, lines 62-67. Video packets are embedded within an audio link).

Regarding claim 31. Bales discloses a system wherein the telephony device is further operable to tunnel a query in the audio communication link to the remote device (column 3, 32-62, fig 1, a query is sent to determine media capabilities of the remote device) the query requesting identification of a remote set of media capabilities associated with the remote device (column 3, lines 32-60), to receive a tunneled response to the query in the audio communication link (column 3, lines 32-60. an acknowledgment is received while an audio communication is established), the response identifying the remote set of media capabilities (column 3, lines 32-60. The response identify the media capabilities of the remote device), to forward the response to the computing device (column 3. lines 30-32. The acknowledgment is forwarded to the computing device); and the computing device is further operable to generate the query (101 generates the request), to receive the response, to determine whether the remote set of media capabilities includes a particular enhanced media capability (101 determines the media capabilities of the remote device), and to communicate enhanced media packets to the remote device in response to determining that the remote set of media capabilities includes the particular enhanced media capability (video communication is established).

Regarding claim 33. Bales discloses a system supporting communications. The system comprises a packet-based telephony device operable to establish an audio communication link with a remote device (fig.1); and a local computing device (104) coupled to the telephony device (103); wherein the telephony device is further operable to receive a tunneled message in the audio communication link from the remote device (101)(column 3, lines 32-60. 101 sends media capability request to 103), the message requesting identification of enhanced media capabilities associated with the local computing device (column 3, lines 32-60), to forward the message to the local computing device (figure 2, 203), to receive a response from the local computing device (207, 208, 209), the response identifying the enhanced media capabilities associated with the local computing device (column 3, lines 32-60), and to tunnel the response in the audio communication link to the remote device (column 3, lines 5-60. the request and the respond are tunneled in the audio link); and wherein the computing device is further operable to receive the message (203), to generate the response (207), to receive enhanced media packets from the remote device (207), and to automatically display at least one enhanced media window in response to receiving the enhanced media packets from the remote device (107, associated with 104, is a display device. 107 displays videos received from 101).

Regarding claim 34. Bales discloses a system wherein the enhanced media packets are video packets and the enhanced media window displays video images (column 3, lines 32-60. 101 and 104 exchange video packets, and 107 displays videos received from 101)

***Claim Rejections - 35 USC § 103***

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 9, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bales in view of Bowman-Amuah (US 6,434,568).

Bales discloses that halting communications on the audio communication link occurs after receiving an instruction from a user (column 3, lines 5-32. the user establishes the communication link through 101. it is inherent for the user to stop the link established through 101).

Bales does not disclose that the instruction selected from a plurality of options comprising hold, transfer, and mute. However, Bowman-Amuah discloses a method where the user has access to multiple instructions, such as holding, transferring, and muting (see column 61, lines 10-35). Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the method implementing phone features through a computer, as taught by Bowman-Amuah, into the communication terminal of Bales for the purpose of enhancing the capabilities and features of video conferencing or instant messaging.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

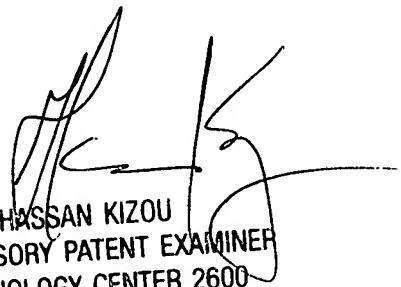
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mounir Moutaouakil whose telephone number is 571-270-1416. The examiner can normally be reached on Monday-Thursday (4pm-4: 30pm) eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mounir Moutaouakil  
Art Unit: 2616



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